In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 601

THE GOODYEAR TIRE AND RUBBER COMPANY, ET AL., PETITIONERS

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the district court (Pet. App. 13a–17a) [1] is reported at 224 F. Supp. 781. The opinion of the court of appeals (Pet. App. 18a–20a) is not yet reported.

JURISDICTION

The judgment of the court of appeals was entered on June 24, 1965. The petition for a writ of certiorari was filed on September 22, 1965. The juris-

[1] "Pet. App." references are to the appendix to the petition. "Pet." references are to the petition. "J. A." references are to the Joint Appendix in the court of appeals, nine copies of which have been filed in this Court.

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diction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether, in a district court suit under 35 U.S.C. 145 to review the Patent Office's refusal to grant a patent, the Patent Office's conclusion regarding obviousness in light of the prior art under 35 U.S.C. 103 should be affirmed unless found to be clearly erroneous.

2. Whether disclosures originally filed before the application in issue, and carried forward in a continuation-in-part application ultimately issued before the application in issue, may be used as a prior art reference to determine obviousness under 35 U.S.C. 103.

STATUTE INVOLVED

Title 35, United States Code, provides in relevant part:

> Section 103. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
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> Section 145. An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have

remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue . . . a patent on compliance with the requirements of law. * * *

STATEMENT

Petitioners Rogers, Bender and Burkholder allege the invention of an improved process for the preparation of flexible cellular materials. Petitioner Goodyear Tire & Rubber Company is the assignee of their interests in the process. By application filed with the Patent Office on June 8, 1955, a patent for the process was sought (Pet. App. 13a).

The claim was denied by the patent examiner (J.A. 289–291, 293–294) on the ground that the process lacked patentability over certain disclosures contained in an outstanding patent, Hoppe et al., No. 2,764,565. The Patent Office Board of Appeals affirmed (Pet. App. 8a–11a, 11a–12a). Petitioners then brought this suit in the district court under 31 U.S.C. 145 seeking a declaration that they were entitled to a patent as applied for. In bringing the suit, petitioners conceded that certain disclosures brought forward in the Hoppe patent as a continuation-in-part of an abandoned 1952

application were a proper reference (Pet. App. 13a, 19a; J.A. 21-22).[2]

After a four-day trial at which new evidence was received, the district court entered judgment for the Commissioner (Pet. App. 14a–17a). The court noted that the issue was one of the obviousness of the advance in the art, and that on that issue the decision of the Patent Office "is presumed to be correct" and "should be followed unless the evidence introduced at trial demonstrates that there is clear error or lack of rational basis in that decision" (Pet. App. 15a). After a thorough examination of the facts, the court concluded that "this case is extremely close," but that it could "not say that the tribunals of the Patent Office were clearly erroneous in holding that the claims in suit were unpatentable over" Hoppe (Pet. App. 17a).

The court of appeals affirmed in a brief *per curiam* opinion (Pet. App. 18a–20a). Citing three of its earlier precedents on the issue, the court noted that the Patent Office's resolution of technical issues such as obviousness "requires affirmance of its judgments unless they have no rational basis" and found that, although there was some contrary evidence, the finding of obviousness "is supported by the record" (Pet. App. 20a). With regard to the relevance of the Hoppe references, the court recognized that petitioners had conceded this issue in the district court but went on to hold that, in any event, the Hoppe reference was a relevant reference as a continuation-in-part of an

[2] Petitioners sought to retreat from this concession in the court of appeals (Pet. App. 19a).

abandoned application predating the application in issue.

ARGUMENT

1. There is no substance to petitioner's contention that the courts below erred in refusing to overturn the Patent Office's determination of obviousness unless found to be clearly erroneous on the basis of the record made in the district court.[3] Such deference was required.[4] As this court ruled with respect to determinations by the Patent Office of the similar question of priority of invention, "* * * the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction"; if the question is "* * * doubtful the decision of the Patent Office must control." *Morgan* v. *Daniels*, 153 U.S. 120, 125. This test has been repeatedly followed by the court below in refusing to overturn Patent Office decisions on technical issues. See *e.g.*, *Abbott* v. *Coe*, 109 F. 2d 449, 451 (C.A.D.C.); *Esso Standard Oil Company* v. *Sun Oil Company*, 229 F. 2d 37, 42 (C.A.D.C.), *certiorari denied*, 351 U.S. 973; *Schafer* v. *Watson*, 288 F. 2d 144, 145 (C.A.D.C.). Despite a slightly different verbal formulation in the opinion in this case (the court, indeed, has recognized that varying

[3] A similar issue is presented in *Sheldon L. Pollack et al.* v. *Commissioner of Patents*, No. 413, now also pending on petition for a writ of certiorari. The Commissioner's brief in opposition to that petition was filed on September 3, 1965.

[4] Petitioners' claim that they have been denied due process was not raised below. The assertion in this Court (Pet. 16–17) is unsupported by reasons or authority.

verbalizations of the same test have occurred in its opinions, see *Besser* v. *Ooms*, 154 F. 2d 17, 18 (C.A.D.C.)) the supporting citations make it clear that no different test was, in substance, employed here (Pet. App. 15a, 20a).[5]

2. Both tribunals of the Patent Office and the two courts below found petitioners' 1955 application unpatentable as obvious in light of disclosures contained in the 1952 Hoppe application.[6] In the district court, petitioners agreed that such prior disclosures, carried

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[5] Nor is it likely, as petitioners suggest (Pet. 15–16), that any different test would have been employed if, instead of seeking a new evidentiary hearing in the district court under 35 U.S.C. 145, petitioners had elected to appeal directly to the Court of Customs and Patent Appeals under 35 U.S.C. 144. For while that court has said that, as a general matter, doubts as to patentability should be resolved in favor of the applicant, see *e.g.*, *In re Citron*, 45 C.C.P.A. (Patents) 773, 251 F. 2d 619, the court also follows the rule that, on an appeal from the decision of the Patent Office, concurrent findings of the administrative tribunals as to obviousness or lack of invention will be persuasive in case of doubt. See *In re Kaufmann*, 39 C.C.P.A. (Patents) 769, 193 F. 2d 331; *In re Smith*, 34 C.C.P.A. (Patents) 1007, 161 F. 2d 274.

[6] The essence of the alleged invention in petitioners' process is the mixing of the ingredients of polyurethane foams at pressures of 0.5 to 60 pounds per square inch above atmospheric pressure to achieve a better end product whose cells are of a uniform and controlled size and which has fewer fissures (Pet. App. 9a, 13a, 18a; J.A. 274). The idea of thus using pressure in the mixing of the ingredients for polyurethane foams was clearly present in the 1952 Hoppe application, which described an apparatus for the production of polyurethane plastics, including foamed products, and told of one modification of the apparatus in which components of the mixing ingredients were injected either through separate nozzles or through a common mixing nozzle into a mixing chamber at a pressure of up to 1000 atmospheres to improve the homogeneity and strength of the end product (Pet. App. 14a, 19a; J.A. 350, 351).

forward in a continuation-in-part application filed by Hoppe shortly after petitioners' application, were a relevant reference in judging the patentability of petitioners' application. See Statement, pp. 3–4, *supra*, at note 2. Petitioners attempted to retreat from their concession in the court of appeals, and that court, while noting that the concession had been made, also held the 1952 disclosures to be proper references regardless of the concession because carried forward into the later Hoppe patent application (Pet. App. 19a).

The court of appeals was clearly correct in giving the relevant Hoppe disclosures a 1952 filing date, since they were a continuation of an application originally filed at that time. See *Asseff* v. *Marzall*, 189 F. 2d 660, 661 (C.A.D.C.). Thus the Hoppe disclosures were properly treated as part of a patent "copending" with the petitioners' application.[1] The remaining question raised by petitioners—whether "copending" patent applications are relevant references in determining obviousness under 35 U.S.C. 103—is presented in *Hazeltine Research, Inc., et al.* v. *Commissioner*, No. 57, this Term, certiorari granted, 380 U.S. 960. The Commissioner's position in that case, upheld by the court of appeals in *Hazeltine* and in this case, is that copending patents *are* relevant references under Section 103.

In view of petitioners' agreement in the district court that the disclosures in the 1952 Hoppe application were available as references to determine the

[1] A "copending patent" is one applied for before the invention and application in issue but granted after the application in issue.

patentability of their application, we do not believe the question in *Hazeltine* to be properly presented in this case. Hence, we submit that the petition for certiorari should be denied. However, inasmuch as the court of appeals appears to have passed upon the question as an alternative ground of decision after petitioners abandoned their district court concession, this Court may conclude that that question is appropriate for its consideration. See *Friend* v. *Talcott*, 228 U.S. 27, 36; cf. *Jones* v. *United States*, 362 U.S. 257, 272. If the Court does so conclude, we respectfully suggest that it defer action on the instant petition pending its decision on the merits in *Hazeltine*.

CONCLUSION

The petition for a writ of certiorari should be denied. In the alternative, action on this petition should be deferred pending the Court's decision on the merits in No. 57, *Hazeltine Research, Inc., et al.* v. *Commissioner*.

Respectfully submitted.

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OCTOBER 1965.

U.S. GOVERNMENT PRINTING OFFICE: 1965

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